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PAUL W. MARTIN
NCR CORPORATION, LAW DEPT.
3097 SATELLITE BLVD., 2nd FLOOR
DULUTH, GA 30096

EXAMINER	
MONFELDT, SARAH M	
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte JOANNE S. WALTER

Appeal 2011-009294
Application 09/751,630
Technology Center 3600

Before, JOSEPH A. FISCHETTI, MEREDITH C. PETRAVICK, and MICHAEL W. KIM, *Administrative Patent Judges*.

FISCHETTI, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellant seeks our review under 35 U.S.C. § 134 of the Examiner's final rejection of claims 1-26. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

SUMMARY OF DECISION

We AFFIRM.

THE INVENTION

Appellant claims a system and method for permitting a consumer to prescribe personal privacy data preferences. (Specification 1:5-6)

Claim 1, reproduced below, is representative of the subject matter on appeal.

> 1. A method for prescribing personal data preferences comprising the steps of:
>
> a) coupling an electronic consumer device to a computer of a business selling goods or services;
>
> b) accessing a personal data preferences program provided by the business as a service to customers of the business and executed by the computer through use of the electronic consumer device that enables a consumer to create a personal privacy profile by choosing, selecting, and then assigning opt in or opt out privacy options to one or more specific, distinct, and different types of personal data collected and maintained by the business including but not limited to the data types of history of purchases from the business by the consumer, demographic data, amount purchased, frequency of purchase, coupon used, payment method used, time of day, week, and year purchased, for the purpose of identifying and limiting the discrete types of data the business is authorized, by the customer's choice of

opt in, to collect, use, and disseminate in accordance with the personal privacy profile data type options selected as opt in by the customer;

c) recording consumer selection of the privacy options via the consumer device by the computer;

d) coding selected privacy options by the computer;

e) downloading coded privacy options to the consumer device by the computer;

f) transferring the coded privacy options to a consumer storage medium separate from the consumer device by the computer;

g) reading the coded privacy options from the consumer storage medium by a transaction computer during a transaction between the consumer and the business; and

h) limiting the collection, use, and dissemination of the personal data by the transaction computer in accordance with the coded privacy options.

THE REJECTIONS

The Examiner relies upon the following as evidence of unpatentability:

Siegel	US 2002/0091562 A1	Jul. 11, 2001

Stepanek, Marcia. Protecting E-Privacy: Washington Must Step In". Business Week, New York: July 26, 1999. Iss. 3639; p. EB30;

PR Newswire. "Love Bug" Virus Raises New Concerns About Password Security. New York: May 12, 2000. (3 pages).

The following rejections are before us for review.

The Examiner rejected claims 1-6 and 8-26 under 35 USC 103(a) as being unpatentable over Siegel in view of Stepanek.

The Examiner rejected claim 7 under 35 USC 103(a) as being unpatentable over Siegel in view of Stepanek and further in view of Love Bug Virus.

ISSUE

The issue of obviousness turns on whether a person with ordinary skill in the art would see as obvious offering a customer the option to restrict dissemination of personal data of purchases on a store by store basis, where Siegel discloses using a global control process, where the customer may restrict data deemed private within an Electronic Information Account (EIA).

FINDINGS OF FACT

We find the following facts by a preponderance of the evidence:

1. We adopt the Examiner's findings as set forth on pages 4-17 of the Answer.

2. Siegel discloses:

> Customers who use[] (sic) these electronic accounts and check cashing cards often fail to share in the benefits afforded the financial institutions and retail merchants. In particular, customers may prefer to exercise control over the use of identifying information. For instance, a customer may want to limit private information available to third parties that link his identity to his purchases. In other instances, a customer may wish to electronically communicate his identifying

> information to the retailer or to the original source of the good or service (e.g., product registration for warranty purposes).

(¶ [0007]).

> 3. Siegel further discloses that the EIA storage device is capable of being controlled by the customer to modify identifying information records for respective public profiles for purposes such as expediting retail purchases and product registrations, e.g., legal name, residential delivery and mailing addresses, telephone numbers, social security number, driver's license state and number, assigned manufacturer customer number, etc.

(¶ [0035]).

4. Siegel discloses that "a user may restrict data deemed private that is not to be remotely stored." (¶ [0039]).

5. Additional findings of fact may appear in the Analysis that follows.

ANALYSIS

We affirm the rejection of claims 1-26 under 35 U.S.C. § 103(a).

The Examiner rejected claims 1-6, 8-26 under 35 U.S.C. 103(a) as being unpatentable over Siegel further in view of Stepanek. Examiner found that Siegel at ¶¶ [7, 13, 22, and 23] discloses limitations [a] and [b] of claim 1 at issue[1]. (Answer 5).

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[1] In the Answer, the Examiner finds that Siegel discloses:
a) coupling an electronic consumer device to a computer of a business (page 2, paragraphs 13 and 22-23); b) accessing a personal data preferences program executed by the computer through use of the electronic consumer

Appellants argue that:

> Siegel discloses limiting customer information that may be provided by an EIA storage device, while Applicant claims limiting customer information that may be collected and disseminated by a seller of goods. The two methods of limiting customer information are different, because limits are set and enforced by different entities, Siegel with an EIA facilitator and Applicant with a seller of goods. Under Applicant's invention, a seller of goods limits collection of customer information as a service to the customer, per customer choices previously made via a computer of the seller.

(Appeal Br. 8-9).

Our review of Siegel shows that the EIA storage device is capable of being controlled by the customer to add product and retailer limitations and to modify identifying information records for respective public profiles for purposes, such as, expediting retail purchases and product registrations, e.g., legal name, residential delivery and mailing addresses, telephone numbers, social security number, driver's license state and number, assigned manufacturer customer number, etc. (FF 3). This is consistent with both

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device that enables a consumer to create a personal privacy profile choosing, selecting, and then assigning opt in or opt out privacy options to one or more specific, distinct, and different types of personal data collected and maintained by the business for the purpose of identifying and limiting the discrete types of data the business is authorized, by the customer's choice of opt in, to collect, use, and disseminate in accordance with the personal privacy profile data type options selected as opt in by the customer (page 1, paragraph 7; page 2, paragraphs 13 and 23).

overall goals of Appellant and Siegel, who discloses limiting private information available to third parties that link a customer identity to his/her purchases. (FF 4).

While we agree with Appellant that in Siegel, the EIA facilitator, and not the company selling the product/service, offers the service of controlling the release of private information, we find that a person with ordinary skill in the art would understand that the EIA facilitator nevertheless offers control similar to that offered by the company selling product/services, and thus would be an obvious variant. That is, we find that because Siegel discloses that the customer may restrict data deemed private that is not to be remotely stored (FF 4), this would effectively serve the same purpose as proposed by Appellant, since in both cases the targeted information is not released. Accordingly, we do not find persuasive Appellant's argument as to the limits of control being set and enforced by different entities because in the end, the restriction on use of the data is still set by the customer in both instances.

As to the specific types of data enumerated in the claims relative to that disclosed by Siegel, we find that any such distinction (Appeal Br. 9-10), is based on the content of such information which we find to be nonfunctional descriptive material because it does not bear on a related function recited in the claims. Patentable weight need not be given to descriptive material absent a new and unobvious functional relationship between the descriptive material and the substrate. *See In re Lowry*, 32 F.3d

1579, 1582-83 (Fed. Cir. 1994).

CONCLUSIONS OF LAW

We conclude the Examiner did not err in rejecting claims 1-26 under 35 U.S.C. § 103(a).

DECISION

The decision of the Examiner to reject claim 1-26 is AFFIRMED.

AFFIRMED

MP